

REMARKS

Claims 40 and 53-60 are pending in the present application.

Claims 40 and 53-60 stand rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For at least the reasons stated below, the Applicants respectfully traverse the above rejections and submit that all pending claims are allowable.

The Office Action states, "It is not clear what is meant by 'indications' of pending messages. Therefore these claims are indefinite." For support for this contention, the Office Action refers to an action ("Parent Action") mailed by the PTO on July 23, 1997 during prosecution of parent application 08/545,108 ("Parent Application"). The Office Action then refers to a statement made by the District Court of Pennsylvania ("Court") in civil action number 03-3138, Agere Systems, Inc. v. Broadcom Corporation. The Office Action states that the Court agreed that such rejection in the parent case was valid.

For context, at issue in the Parent Application was the claim language "each of the one or more base stations transmitting indications of pending messages at selected time intervals." The Examiner issued a rejection of then pending claim 39, stating that it was not clear what was meant by "indications of pending messages."

The Office Action is incorrect that the Court agreed with the above-mentioned rejection. For example, such rejection was not being challenged before the Court and thus had not been briefed by the parties for thoughtful consideration by the Court. The Court's statements were made with regard to a different, albeit tangentially related, matter and thus were mere *dicta* and non-binding with regard to the appropriateness of the mentioned rejection.

Additionally, the Court merely stated, "The word 'indication' is extremely broad – it could refer to literally *anything* (e.g., a single bit, a buzzer, a flashing light) that informed the roaming terminal that it had a message pending. The term 'list' is considerably narrower, specifying that the terminal is not simply being notified that messages are pending but also being given *some* information." Thus, the Court appeared to at least imply that "being given *some* information" was somehow preferable to the more broad term "indication."

Though, arguably, the Court's statement with regard to the Parent Application that the claimed "indication" could refer to "literally *anything*" (including a buzzer and a flashing light) might be considered unreasonable considering the context of being transmitted by a base station of an RF data communication system to a terminal of the RF data communication system, the Applicants have added clarifying language to the present claims of the present application to indicate that the claimed "information packets" comprise "information indicating pending messages" rather than "pending message indications." Thus, in a generally analogous manner to the Parent Application, the presently pending claims specify information. Note, however, that by no means is the presently claimed "information indicating pending messages" to be limited to a list, as specified in the Parent Application.

In summary, for at least the aforementioned reasons, the Applicants submit that all pending claims are in conformance with 35 U.S.C. § 112, ¶ 2, and in condition for allowance. Accordingly, the Applicants courteously solicit a Notice of Allowability with respect to all pending claims. The Applicants take this opportunity to respectfully request an Examiner Interview to discuss the pending claims and the present response. In particular, the Applicants request such an Examiner Interview prior to any final rejection of the pending claims. The Applicants invite the Examiner to contact the undersigned at 312-775-8000 to arrange such an interview at the Examiner's convenience. Additionally, if the Examiner has any further questions, the Applicants invite the Examiner to contact the undersigned to discuss such questions.

Appl. No. 09/318,668
Resp. dated March 13, 2007
Resp. to Office Action of Oct. 13, 2006

The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: March 13, 2007

Respectfully submitted,

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